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| William A. Munck, Esq NOVAKOV DAVIS & MUNCK, P.C. 900 Three Galleria Tower 13155 Noel Road Dallas, TX 75240 | | | ART UNIT | PAPER NUMBER |
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

MAILED

Application Number: 09/694,425
Filing Date: October 23, 2000
Appellant(s): USSERY, TROY ALAN.

MAY 03 2005

GROUP 3600

Frederick D Hamilton
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 21, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The grouping of the claims in the brief is correct.

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

| | | |
|---------------------|-------------------------|---------------|
| 5,729,694 | Holzichter et al | 3-1998 |
| 6,393,410 B1 | Thompson | 5-2001 |

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims: This rejection is set forth in Final Office Action, dated January 10, 2004.

(11) *Response to Arguments*

Group I - Response to arguments in support of the patentability of claims 1 – 5, 8 – 15 and 18 – 20.

Group II – Response to arguments in support of the patentability of claims 6, 7, 16 and 17.

Group I - Response to arguments in support of the patentability of claims 1 – 5, 8 – 15 and 18 – 20.

It is noted that Appellant's arguments are directed to the system claim's of which claim 1 is representative and the Examiner will respond to each argument.

First and in response to applicant's argument that Thompson does not teach or suggest a system structure with the intended use of an electronic commerce system, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). In that regard and when considering a system claim, the consideration and examination is focused on the structure, which is capable of performing the intended use as recited in the preamble of claim 1 "for use over a global communication network having company (first) nodes and constituency (second) nodes associated therewith, an electronic commerce system comprising".

Second, the structure of claim 1 as claimed and argued includes structure with “a data repository operable to store data files”, “a communication controller” and to “(i) propagate a communication interfaces accessible by said constituencies nodes with selected portions of said company information under direction of said company nodes (ii) gather feedback information representative of constitutes response”. Thompson does disclose the structure required for a “data repository”, a communication controller as well as the structure to propagate communication interfaces (i.e. browsers) and gather representative feedback. For example, Thompson discloses the required structure for a data repository/database, which is accessible to and communicates via interfaces over the Internet with nodes of architects (first) and constituents (second) such as contractors (see at least Abstract and Figure 1). With respect to the “data files”, the examiner concedes that Thompson does not have the exact content of the “data files” as claimed. On the other hand, the difference between the “data files” of Thompson and the instant invention is characterized as non-functional descriptive material, which is given little patentable weight (MPEP 2106). The “data files” stored in the repository are given little patentable weight because the claim language limitation is considered to be non-functional descriptive material, which does not patentably distinguish the applicant’s invention from the structure of Thompson. Thereby, the non-fictional descriptive material is directed only to the content of the data (i.e. data files with company information - which is stored data) and does not affect either the structure or method/process of Thompson, which leaves the method and system unchanged. Moreover, Thompson does fully disclose that the users for each project upload

information on each project to a network accessible data repository/database (see at least Col 1, lines 23 – 43, Col 2, lines 40 - 44 and Figure 2). In turn, these project(s) under control and direction of the project supervisor transmits via a communications controller the interfaces (i.e. browsers), which consist of the selected portions of the stored information to constitutes such as contractors (see at least Abstract, Col 3, lines 30 – 34 and Figures 1 - 3). Constitutes/contractors, in turn would have provided feedback by first purchasing the information as well as providing bid information to the system of Thompson (see at least Figure 3). Thereby, Thompson discloses a *structure* capable of providing a network accessible database, which stores uploaded information in files and a communications controller operable to transmit interfaces consisting of selected portions of the stored information under control and direction of a party as well as gathers representative feedback information (see at least Abstract, Col 1, lines 22 – 44, Col 2, lines 40 – 44, Col 3, lines 25 – 67, Col 4, lines 1 – 45 and Figures 1 - 6). Of further note, the appellant at page 9 does assert that the claim reads that the controlling party does not have control - after the information is sold by the system of Thompson. However, the claim does not in fact recite this. Rather, claim 1 only recites "information under the direction of said company (first) nodes", which Thompson discloses and therefore suggests to one of ordinary skill the requisite structure in the reference as noted above.

Appellant remarks at pages 5 - 7 of the brief that the Examiner did not provide an adequate *prima facia* case of obviousness for claims 1 – 5, 8 – 15 and 18 – 20 and concentrates their arguments with respect to claim 1.

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the problem to be solved is for a system with the *structure* capable of providing a network accessible database, which stores uploaded information in files and in turn a communications controller operable to propagate/transmit interfaces consisting of selected portions of the stored information under control of a user/party as well as gathers representative feedback information. For example, an electronic commerce system with the requisite structure used in other applications such as the construction industry would have been an obvious candidate for one of ordinary skill. In this regard and noted above, Thompson an electronic commerce system would have provided the required structure and thereby an obvious selection. Thus, the system of Thompson does disclose and would have suggested the required *structure*. Therefore, one of ordinary skill in the art would have been motivated to extend Thompson to a system requiring the *structure* to

solve this problem in another application/industry - in order to reduce cost and time associated with developing a completely new solution.

Appellant remarks/alleges at page 10 of the brief that Thompson does not suggest or teach the limitations claimed in dependent claims 2- 5 and 8 –10 as well as claims 11 – 15 and 18 – 20.

Since the appellant did not provide any arguments of note and in response, the appellant is referred to the above.

Group II – Response to arguments in support of the patentability of claims 6, 7, 16 and 17.

Appellant remarks at page 11 and 12, that the Examiner provided too general a motivation to combine Thompson with Holzrichter.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Thompson teaches an authentication of a user whereby the user must enter a password and the

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system structure also includes a security controller (Col 4, line 9). In turn, Holzrichter discloses a system structure, which includes an interactive voice recognition controller that is operable to verify/authenticate the identity of personnel (Col 5, lines 1 – 7). Thereby, one of ordinary skill in the art would have been motivated to extend the system of Thompson with a system including the structure, which has an interactive voice recognition controller that is operable to verify/authenticate the identity of personnel. In this manner, the system implementation cost and time will be reduced as well as providing an additional mode of authentication for disabled individuals without hands and thereby enabling more personnel to use the system.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

RER
April 29, 2005

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